



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,107	01/10/2002	Michael Mrochen	31567.4	6012

7590

01/28/2004

J Andy Lowes  
Haynes and Boone  
901 Main Street Suite 3100  
Dallas, TX 75202-9918

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
----------	--------------

3739

10

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/031,107

Applicant(s)  
Mrochen et al.

Examiner  
Ahmed M. Farah

Art Unit  
3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 18-34 is/are pending in the application.
- 4a) Of the above, claim(s) 27 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 18, 21, 24, 28, and 29 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 22, 23, 25, 26, 30, and 31 is/are objected to.
- 8) ☒ Claims 1 and 18-34 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5 6) ☐ Other:

Art Unit: 3739

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election of invention I, group A (claims 1, 18-26, and 28-31) in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 27 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 9.

### ***Claim Objections***

3. Claim 30 is objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. For example, claims 30, which recites the limitation "according to one of the preceding claims," cannot depend claims 19 and 21 because they are multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.
4. Claim 31 is objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim should refer to other claim in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Art Unit: 3739

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “and/or” renders the claims indefinite, because it is not clear what is included or excluded in the claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 18, 21, 24, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hohla U.S. Patent No. 5,683,379.

Art Unit: 3739

Hohla discloses apparatus and method for modifying corneal surface to correct vision disorders, the apparatus comprising a computer system (control unit 64) and control program, according to which a laser-beam spot is guided, while being controlled with respect to position, time and angle, over the cornea to be corrected so as to ablate a predetermined ablation profile as presently claimed.

9. Claims 1, 21 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Yee et al. U.S. Patent No. 6,673,063 B2.

Yee et al. disclose apparatus and method for correcting vision disorders, the apparatus comprising a computer system and a control program for scanning a laser-beam spot over a corneal surface to be ablated, wherein the control program takes into account the time, position, and the angle between the laser beam and the corneal surface as presently claimed.

#### ***Allowable Subject Matter***

10. Claims 19, 20, 22, 23, 25, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:


Art Unit: 3739

U.S. Patent No. 6,245,059 to Clapham; U.S. Patent No. 6,413,251 B1 to Williams; U.S. Patent No. 6,530,917 to Seiler et al; U.S. Patent No. 5,740,815 to Alpins; and U.S. Patent No. 5,163,934 to Munnerlyn disclose methods and apparatuses for correcting vision disorders, the apparatuses comprising various types of control programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be reached on (703) 308-0994. The official fax number for the group is (703) 872-9302; the fax number for After Final is (703) 872-9303; and the Examiner's Desk-top fax is (703) 746-3368.

**A. M. Farah**

**Patent Examiner (Art Unit 3739)**

  
January 22, 2004.